

REMARKS

Applicants have carefully reviewed the Office Action. Claims 1-22 are pending in the application. Claims 1-22 are rejected. Claims 17-20 are amended. No new matter is added. Reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

Objection to Claim 17

Claim 17 is objected to because the term “selectively” appears to be unnecessary. *Office Action*, p. 2. The Office Action further asserts that “It is inherent that a system will generate metadata regarding only data which is relevant or important to its users.” *Id.* This objection is traversed.

As shown in Figure 1 of the present application, an insurance applicant completes an insurance form, e.g., a submitted form 14. *U.S. Patent Application 2005/0182667*, para. [0036]. The submitted form 14 contains “submitted data 15,” e.g., information entered by the insurance applicant. *Id.* The insurance applicant submits the submitted form 14 to a suitable insurance data processing system 20. *Id.* Using the information from the submitted form 14, a data entry operator may enter various entered data 17 into an internal electronic form 16. *Id.* While entering the entered data 17, the data entry operator can make “an appropriate metadata notation through operation of the metadata portion 320. *Id.* at para. [0050]. For example, where a field in a form is left intentional blank, “field left intentionally blank” metadata tells the system that the data operator did not miss entering a field, but rather the data field on the original document was left intentionally blank. *Id.* at para. [0043]. In another example, the metadata can indicate that a field is “unreadable.” *Id.* at para. [0044]. For a more detailed entry of the metadata that can be entered, see, e.g., paragraphs [0041] - [0047]. Since the data entry operator can “select” the metadata to be associated with the entered data, the date entry operator is “selectively generating

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

metadata associated with the entered data.” Hence, the term “selectively” in claim 17 is not unnecessary. Therefore, it is respectfully requested that the objection to claim 17 be withdrawn.

Rejection of claims 17-20 under 35 U.S.C. § 101

Claims 17-20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *Office Action*, p. 2. Specifically, the Office Action recites that “Claim 17 is a method claim which does not recited a device for carrying out the method.” *Id.* Claim 17 is amended and now recites “A computer-implemented method ...” and claims 18-20 are amended and now recite “The computer-implemented method ...” Hence, claims 17-20 now include a device for carrying out the method. As a result of these amendments, the rejection of claims 17-20 is rendered moot. Therefore, it is respectfully requested that the rejection of claims 17-20 be withdrawn.

Rejection of Claims 1-3, 6, 10-13, & 16-21 under 35 U.S.C. § 103(a)

Claims 1-3, 6, 10-13, and 16-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,151,584 to Papierniak (“Papierniak”) in view of U.S. Patent 6,415,284 to D’Souza (“D’Souza”). This rejection is traversed.

The Office Action fails to establish a *prima facie* case of obviousness. As recited in Section 2142 of the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 2 USPQ2d 1438 (Fed. Cir. 1991).

Neither Papierniak nor D’Souza, neither singularly nor in combination, teach or suggest “A system for performing data collection of insurance related submitted data provided by an applicant for insurance on a submitted form, the system comprising: a data input portion that inputs the submitted form so that the submitted data on the submitted form is available to a data entry operator; and a data collector tool, which processes entered data that is entered by the data entry operator, onto an internal electronic form, based on the submitted data submitted by the applicant, the data collector including: a form flow portion that presents the data entry operator

with a series of form flows for collection of the submitted data, the form flows progressing through various user interface screens in collection of the submitted data, the form flows using content sensitive logic; and a metadata portion that generates metadata, the metadata containing information about the entered data, the metadata being progressively generated during progression of the form flows through the various user interface screens.” as recited in claim 1 of the present application. (Emphasis added).

The Office Action asserts that column 18, lines 51-6 of Papierniak teaches “a data collector tool, which processes entered data that is entered by the data entry operator, onto an internal electronic form, based on the submitted data submitted by the applicant.” *Office Action*, p. 3. Exemplary support for this limitation is found in the published patent application, US 2005/0182667. For example, Figure 1 shows a flow chart for a process starting with “an insurance applicant 10 completing an insurance form, i.e., a submitted form 14.” *US Patent Application 2005/0182667* at para. [0036]. “The information that the insurance applicant 14 enters on the submitted form 14 is herein characterized as ‘submitted data 15.’” *Id.* “[t]he submitted data 15 is entered into a suitable insurance data processing system 20 of the insurance entity. *Id.* “This data entry may be performed by a data entry operator 11.” *Id.* “Based on the information in the submitted form 14, the data entry operator 11 enters various entered data 17 on the internal electronic forms 16.” *Id.*

The Office Action’s assertion of Papierniak is unclear in that lines 51-6 are asserted. This assertion is unclear, e.g., is the Examiner referring to lines 51-56 or if this is a typo with the last line number being inadvertently missed. In addition, since a sentence does not end in line 56, the undersigned does not believe the Examiner is referring to line 56. Correction of this assertion is requested in a second Non-Final Office Action since the Office Action fails to properly assert the section of Papierniak that teaches this limitation. Regardless of what is being asserted by the Office Action, Papierniak recites that:

WebTrack/WebMap collects and extracts information from customer operational systems. The collected and extracted information will be further manipulated to determine the identity and characterization of the users via the Mapping Utilities. Data Transformation Tools 346 load the data into the WebWarehouse based on the principles of the WebWarehouse Designer and the information discovered during the execution of Collection/Extraction Utilities and Mapping Utilities.

WebWarehouse is the physical repository of WebMining or SmartEC Decisions information.

WebSmart provides the intelligence of the present invention. Decision Support Systems (DSS) tools 348 provide the access, query, and report capabilities using WebWarehouse. Data Mining tools 350 enable the present invention to discover hidden knowledge from existing data and information. Furthermore, Data Mining tools could establish systems model such that Prediction/Forecasting 352 capabilities can be realized. All these intelligence can be formulated such that the business impact can be clearly crystallized via Business Impact Report 354.

Papierniak, C. 18, line 51 - C. 19, l. 4. *Papierniak* teaches collecting and extracting data from customer operational systems. In contrast, the entered data is coming from a submitted form. Thus, *Papierniak* teaches or suggests that the data is coming from a different source: "customer operational systems rather than submitted forms. In addition, *Papierniak* fails to teach or suggest that a data collector tool "processes entered data that is entered by the date entry operator, onto an internal electronic form, based on the submitted data submitted by the applicant" as required by claim 1 of the present application. *Papierniak* does not teach or suggest the use of an "internal electronic form." Thus, *Papierniak* fails to teach or suggest each and every limitation of claim 1 of the present application and D'Souza is not being asserted as teaching this limitation.

The Office Action asserts that column 6, lines 60-62 and column 22, lines 6-13 of *Papierniak* teaches "a form flow portion that presents the data entry operator with a series of form flows for collection of the submitted data, the form flows progressing through various user interface screens in collection of the submitted data" as recited in claim 1 of the present application. The first asserted section discloses that Figures 13 and 13A of *Papierniak* provide "detailed illustrations of the Data Discoverer architecture in accordance with the present invention;" *Papierniak*, C. 6, ll. 60-62. Figure 13 shows the Data Discoverer Architecture and Figure 13A shows the process for using the Data Discoverer architecture. The second asserted section recites that:

The results of the data discovery process is highly iterative and highly dependent on the customers' needs. The purpose of data discovery is to achieve a starting point for a systematic way of discovering customer information. Interview templates and/or forms are provided to guide the user through the process of identifying and recording information pertinent to WebWarehouse that describes the customers' information systems.

Papierniak, C. 22, ll. 6-13. These asserted sections of *Papierniak* teach or suggest a system for obtaining information about customers' information systems. In contrast, claim 1 of the present application is directed towards "A system for performing data collection of insurance related submitted data with a data entry operator entering the "submitted data" through a form flow portion. *Papierniak* does not teach or suggest entering insurance related submitted data, but rather information describing the customers' information systems. Since *Papierniak* does not teach or suggest entering the insurance related submitted data, *Papierniak* cannot teach or suggest "the form flows progressing through various user interface in collection of the submitted data" as required by claim 1 of the present application. Thus, *Papierniak* fails to teach or suggest each and every limitation of claim 1 of the present application and D'Souza is not being asserted as teaching this limitation.

As admitted in the Office Action, "Papierniak does not teach the following feature which is taught by D'Souza (Col. 1, Ln. 53-59): wherein the form flows use content sensitive logic[.] At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of *Papierniak* with the above teachings from D'Souza with the motivation of having a means of validating data, as recited in D'Souza (Col. 1, Ln. 53-54)." *Office Action*, pp. 3-4. Claim 1 of the present application recites that "the form flows using content sensitive logic." Exemplary support for this limitation can be found in the specification, which recites that:

Essentially, the formflow serves as a digital "script" that guides the DEO, for example, through the data entry process in a predetermined manner, which is deemed by the designers of the script to be the most logical and/or efficient manner. Content sensitive logic is an integral part of the formflow concept. That is, certain data elements are presented to the DEO only when appropriate and relevant. Again, this logic is built into the formflow "script" to reduce screen clutter, eliminate distractions to the DEO, and to reduce opportunities for human error. Content sensitive logic features as described herein might be characterized as a feature that progressively discloses further fields (for the data entry operator to complete) based on the content of a field currently displayed.

U.S. Patent Application 2005/0182667 at para. [0032]. Hence, reading claim 1 in view of the specification, it is clear that the content sensitive logic feature may be characterize "as a feature that progressively discloses further fields (for the data entry operator to complete) based on the content of a field currently displayed." The Office Action asserts D'Souza for teaching this limitation with the asserted section reciting:

Verification logic verifies that the employee has entered valid form data in a particular field. The verification logic can include references to data items stored in the comprehensive company database such that data entered by the employee can be verified with respect to data already stored in the database. Accordingly, introduction of errors in form data is further prevented.

D'Souza, C. 1, ll. 53-59. This asserted section of *D'Souza* discloses the use of verification logic that “verifies that the employee has entered valid form data in a particular field.” Thus comparing this asserted section of *D'Souza* with “the form flows using content sensitive logic” limitation of claim 1 of the present application, it is clear that this asserted section of *D'Souza* fails to teach or suggest the content sensitive logic recited in claim 1 of the present application. In other words “verification logic” is different from “content sensitive logic.” Thus, *D'Souza* fails to teach or suggest each and every limitation of claim 1 of the present application and it is admitted that *Papierniak* does not teach this limitation.

In addition, since *D'Souza* does not teach the “content sensitive logic” of claim 1, one of ordinary skill in the art would not have been obvious for one of ordinary skill in the art to have modified the teachings of *Papierniak* with the teachings from *D'Souza*.

Regarding claim 3 of the present application, the Office Action asserts that “in *Papierniak*, the metadata portion presents the data entry operator with a plurality of metadata to choose from so as to capture information about the entered data (*Papierniak*: Col. 19, Ln. 4-11).” *Office Action*, p. 4. *Papierniak* recites that:

Since there are multiple systems and databases involved in providing WebMining or SmartEC Decisions solutions, it is important to properly manage, coordinate, and reconcile the different sets of metadata. Metadata Management Utilities serve as a control center of these different metadata for the present invention.

Papierniak, C. 19, ll. 5-10. As discussed above with respect to claim 17 of the present application, the data entry operator may choose to enter different metadata, e.g., “field left intentionally blank” metadata or “unreadable” metadata. This asserted section of *Papierniak* teaches that “it is important to properly manage, coordinate, and reconcile the different sets of metadata.” This asserted section does not teach or suggest that the metadata portion that generates the metadata allows the user to choose the metadata “so as to capture information about the entered data.” In other words, *Papierniak* does not allow the user, e.g., data entry operator, to choose the metadata that is associated with the entered data. Thus, *Papierniak* fails

to teach or suggest each and every limitation of claim 3 of the present application and D'Souza is not being asserted as teaching this limitation.

For at least these reasons, the Office Action fails to meet the *prima facie* burden of obviousness with respect to claim 1 of the present application. Since independent claims 17, 21, and 22, contain similar limitations as recited in claim 1 and argued above, these claims are patentable over the applied art for the same reasons recited above with respect to claim 1.

For at least these reasons, independent claims 1, 17, 21, and 22, as well as dependent claims 2-16 and 18-20, respectively, are patentable over the applied art. Since the dependent claims are patentable over the applied art based on their dependency on the allowed independent claims, the undersigned representative will not address the arguments with respect to these claims and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 1-3, 6, 10-13, 16-20, and 21 is requested.

Rejection of Claims 4 & 5 under 35 U.S.C. 103(a)

Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak in view of D'Souza and in further view of U.S. Patent Application 2004/0123202 to Talagala ("Talagala"). Since claims 4 and 5 are dependent on allowable independent claim 1 and since Talagala does not cure the deficiencies of Papierniak and D'Souza with respect to claim 1, dependent claims 4 and 5 are allowable as well. Therefore, the undersigned representative will not address the arguments with respect to claims 4 and 5 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 4 and 5 is requested.

Rejection of Claims 7-9 under 35 U.S.C. 103(a)

Claims 7-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak in further view of Official Notice. This rejection is improper in that claim 1, the parent claim of claims 7-9, is rejected based on Papierniak in view of D'Souza, but this rejection does not assert D'Souza. Since claims 7-9 are dependent on allowable independent claim 1 and since Official Notice does not cure the deficiencies of Papierniak and D'Souza with respect to claim 1, dependent claims 7-9 are allowable as well.

The taking of Official Notice with respect to claims 7-9 is traversed. Rather than cite a reference for teaching or suggesting these limitations, the Office Action takes Official Notice for each of these limitations. It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection

was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); MPEP 2144.03 (Emphasis added). The MPEP further recites that:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

MPEP 2144.03A. (Emphasis added). The summary of this section further recites that:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.<

MPEP 2144.03.

The Office Action asserts Official Notice despite the MPEP stating that Official Notice should be used rarely. In this Office Action, Official Notice is taken to reject four claims. Rejecting four claims is excessive, improper and is certainly not being used judiciously.

Since this rejection is improper, the undersigned representative will not address the arguments with respect to these claims and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 7-9 is requested.

Rejection of Claim 14 under 35 U.S.C. 103(a)

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak in view of D'Souza and in further view of Official Notice. Since claim 14 is dependent on allowable independent claim 1 and since Official Notice does not cure the deficiencies of Papierniak and D'Souza with respect to claim 1, dependent claim 14 is allowable as well.

In this rejection, the Office Action recites that:

The combined teachings of Papierniak in view of D'Souza do not teach that the validation portion performs a validation process on a page upon exiting a page, however, the Office takes the position that this feature is inherent because a validation module cannot perform a validation process until it has read all the information in a field and this cannot be done until the validation module has exited the field.

Papierniak in view of D'Souza do not teach that the internal electronic form is arranged based on pages of the internal electronic form, however, the Office takes the position that this is a feature well known in the software and data management and information technology fields and at the time of the invention one of ordinary skill in the art would have been motivated to have modified the aforementioned teachings of Papierniak in view of D'Souza with the above teachings with the motivation of having a convenient and logical means of organizing information on the internal electronic form.

Office Action, pp. 7-8. Claim 14 recites that “the validation portion performs a validation process on a page upon exiting the page.” As admitted in the Office Action, the applied art does not teach or suggest performing a validation on a page upon exiting a page. Rather than asserting a reference for teaching use of pages, the Office Action takes Official Notice. In addition, the Office Action asserts that it is inherent that validation cannot occur until the validation module has exited the field. Again, the Office Action fails to assert a reference for this teaching. In addition, the only motivation the Office Action asserts is “the motivation of having a convenient and logical means of organizing information on the internal electronic form.” *Office Action*, pp. 7-8. This motivation is not cited in the applied art.

In *KSR International Col. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court did not eliminate the teaching, suggestion, or motivation (TSM) test from the determination of obviousness, but rather merely opposed “a formalistic conception of the words teaching, suggestion, and motivation, or ... overemphasis on the importance of published articles and the

explicit content of issued patents." *KSR International Col. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). As the Federal Circuit has subsequently explained:

[A] flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis.... The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) – that arise before the time of invention as the statute requires.

Ortho-McNeil Pharmaceutical v. Mylan, 2007-1223, *11 (Fed. Cir. Mar. 31, 2008) (emphasis added). Thus, to establish a *prima facie* case of obviousness the Examiner must show *evidence* of teaching, suggestion, or motivation to make the proposed combination of references that arose before the time of invention. Such a showing is required to guard against allegations of obviousness that are actually derived from impermissible hindsight.

The rejection of claim 14 is improper, *inter alia*, in that the rejection is based on impermissible hindsight and the use of Official Notice is improper. Withdrawal of the rejection of claim 14 is requested.

CONCLUSION

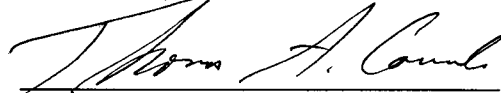
The foregoing is submitted as a full and complete Response to the Non-final Office Action mailed July 16, 2008, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (703)714-7448 is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0206, and please credit any excess fees to such deposit account.

Dated: October 16, 2008

HUNTON & WILLIAMS LLP
1751 Pinnacle Drive, Suite 1700
McLean, VA 22102
Phone 703-714-7400
Fax 703-714-7410

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thomas A. Corrado", written over a horizontal line.

Thomas A. Corrado
Attorney for Applicant
Registration No. 42,439